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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/696,344

10/29/2003

Christian Schmid

200315617-1

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06/05/2008

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EXAMINER

SHAH, MANISH S

ART UNIT

PAPER NUMBER

2853

NOTIFICATION DATE

DELIVERY MODE

06/05/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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***Response to Arguments***

1. Applicant's arguments filed 05/12/2008 have been fully considered but they are not persuasive.
2. Applicant argued on pages 7 & 8 of the remarks, that the Pentel does not disclose the what purpose or for what function the ascorbic acid derivative is used. According to the present claim language, as long as reference has same chemical it works for same function and solve the same purpose. In rejection of claims 1-12 & 27-28, the Pentel is a primary reference, so it doesn't required reasoning, why they use ascorbic acid. However applicant didn't claim the invention, why they use the ascorbic acid in the highlighter composition, to over the Pentel reference, applicant has to claim why they using ascorbic acid. Applicant in their own specification, they disclose that acid buffer is ascorbic acid, and Patel also teaches that highlighter contains ascorbic acid. Therefor Panel still reads on the present claim language.
3. Applicant argued on page 11 that Pentel does not disclose an acid buffer further containing weak acid or weak base, which not persuasive. Applicant discloses in their own specification paragraph [0011] is that the weak acid has pKa value is more then 3, however the pKa value of ascorbic acid is more then 3. Therefore Pentel discloses acid buffer is weak acid. However, applicant didn't give specific name of the weak acid or base. Therefor Pentel reads on the present claimed language.
4. Applicant also argued that the Mammen teaches away from the addition of acid. However, Mammen didn't discloses that the addition of acid is not good. However, examiner combine this reference to show that to reducing smear (see Abstract; [0277])

during highlighting including the highlighter composition having a florescent highlighter colorant (see Examples), and a liquid vehicle, wherein liquid vehicle is water, diethylene glycol, propylene glycol (see Examples), and highlighter colorant is fluorescent and selected from Acid Blue 9 ([0111], see Example: 3-4). Therefore it obvious to combine Pentel and Mammen.

5. Applicant argued that the succinic acid in the Kaufmann reference is an anti-blocking agent. However applicant claimed “acid buffer”, which means just acid, they didn’t claim why they using it. Therefore it is proper to combine the Kaufmann reference with Pentel and Mammen et al.

6. Applicant argued that substitution of the specific ascorbic acid derivative with succinic acid is improper, which is not persuasive. Pentel clearly discloses highlighter comprises acid compound, selected from ascorbic acid, etc. which means any other acid also can be used. Therefore, it is proper to substitute ascorbic acid with succinic acid as taught by Kaufmann.

7. Applicant argued the Kaufmann did not discloses the acid-functionalized pigment. However, applicant didn’t define or give any particular name of the acid functionalized pigment in the specification, and Kaufmann discloses the Pigment red 112. Therefore it is proper to combine Kaufmann with Pentel and Mammen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Manish S. Shah/  
Primary Examiner  
Art Unit 2853

/MSS/